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EXAMINER	
THOMAS, J	
ART UNIT	PAPER NUMBER
2411	18

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 8/28/96

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 (three) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- [x] Claim(s) 1-64 are pending in the application.
  - Of the above, claim(s) 4-10, 12, 19-20, 23-30, & 32-39 are withdrawn from consideration.
- [ ] Claim(s) _____ is/are allowed.
- [x] Claim(s) 1-3, 11, 13-18, 21-22, 31, and 40-64 are rejected.
- [ ] Claim(s) _____ is/are objected to.
- [ ] Claim(s) _____ are subject to restriction or election requirement.
- [ ] Claims _____

Application Papers

- [ ] See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- [ ] The drawing(s) filed on _____ is/are objected to by the Examiner.
- [x] The proposed drawing correction, filed on 8/28/96 is [x] approved [ ] disapproved.
- [ ] The specification is objected to by the Examiner.
- [ ] The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- [x] Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - [x] All [ ] Some* [ ] None of the CERTIFIED copies of the priority documents have been
    - [x] received.
    - [ ] received in Application No. (Series Code/Serial Number) _____.
    - [ ] received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

- [ ] Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- [x] Notice of Reference Cited, PTO-892
- [x] Information Disclosure Statement(s), PTO-1449, Paper No(s). 14
- [ ] Interview Summary, PTO-413
- [ ] Notice of Draftsperson's Patent Drawing Review, PTO-948
- [ ] Application, PTO-152

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 6/3/96. Claims 1-3, 11, 13-18, 21, 22, and 31 continue pending. Claims 40-64 are newly added. Claims 4-10, 12, 19-20, 23-30 and 32-39 were withdrawn from further consideration by the Examiner in the previous Office Action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 11, 13-18, 21, 22, and 31, and newly added claims 40-42 and 45-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girouard et al. (4,892,346), for substantially the same reasons given in the prior Office Action·

(paper number 11). Further reasons are given below.

(A) Claim 1 has been amended to now recite "issued points" in the preamble and in the point notification means (line 9). As noted in the prior Office Action, Girouard teaches counts are credited to customer based on the frequency of transactions or visits (Girouard; figure 56; col. 18, line 64 to col. 19, line 5). In particular, upon a shopper first visit, a user's "first time/visit" is recorded by the frequent shopper routine (reads on issuing points) and any subsequent visit is accumulated thereto based on predetermined criteria (Girouard; col. 20, lines 1-22).

Claim 1 has further been amended by the deletion of "data entered through a customer or store terminal", the deletion of identification "by the customer identification means" and the deletion of "cumulative". Although the deletion of the above features affects the scope of the originally filed claim by making the claim broader, it has been held that the omission of an element with the subsequent loss of its function is obvious. *In re Porter*, 20 USPQ 298.

The remaining changes to claim 1, namely the insertion of the terms "wherein" and "the" points, as well as replacing "for

notifying" with "notifies", are considered to be minor changes that do not affect the scope of the claim as originally presented, and appear to have been made to reflect the other amendments to the claim, discussed above. Thus, the remainder of claim 1 is rejected for the same reasons given for claim 1 in the prior Office Action, and incorporated herein.

(B) Claims 2-3 and 11 have been amended to now be in independent form rather than their original dependent forms. These amendments merely incorporate the "point issue means", "point accumulation means", "point notification means", and "costumer identification means" of claim 1 as well as the preamble of claim 1, and is therefore rejected under the same rationale given above and in the prior Office Action, for claim 1.

As per the recitation of "store terminal" or "customer terminal", Girouard clearly teaches that his system be located in a mall or other retail area (Girouard; col. 3, line 66) and that customers interact with his system (Girouard; col. 36-55).

As per the recitation of notifying a customer of points prior to a transaction, Girouard teaches that his Mall Promotion Network tracks "the frequency of [customer identification] card

scans and awards coupons, discounts, rebates, or prizes based on a schedule and the number of visits. If the card is scanned at the same time that a chit (i.e., a receipt or "playing cards") is scanned, the Mall promotion Network could track the number of visits or by the customer purchases and award prized on this basis as well." (Girouard; col. 4, lines 16-20 & 29-35). Further, Girouard's Mall Promotion Network can dispense discount coupons, rebate tickets, and discounts tickets at customer's requests (Girouard; col. 4, lines 36-55). It is well known in the art that discount coupons and "playing cards" are issued prior to a transaction, namely prior to the purchase of a discounted item by the customer or prior to a sweepstakes drawing of a customer's playing card. Thus, the Examiner respectfully submits that it would have required no hindsight on the part of one having ordinary skill in the art at the time of the invention to modify Girouard's Mall Promotion Network to notify customer of his or her frequent shopper status or counts (i.e., points), upon their request, prior to the customer's transactions, with the motivation of enabling the customer to review his status so as to give further flexibility and choice to the customer in deciding how he or she wishes to proceed (i.e., whether to redeem his

current counts or to continue accumulating more counts).

The remainder of claims 2-3 and 11 are rejected for the same reasons given for those claims in the prior Office Action, and incorporated herein.

(C) As Applicant has not provided any further amendments with respect to claims 13-18, 21, 22, and 31, the grounds of rejection for these claims are maintained from the previous Office Action (paper number 11; pages 6-8).

(D) Newly added claims 40 and 45-53 are similar in scope to originally filed claims 3, 11, 13, 14, 15, 16, 17, 21, 18, and 22, respectively, and are therefore rejected under the same rationale given for those claims in the prior Office Action (paper number 11).

(E) As per claim 41, Girouard teaches a plurality of multi-media devices and communications circuits as notification means (Girouard; col. col. 5, lines 15-50 and figs. 2-5) and further teaches that his promotion network program "never terminates, it runs forever, or at least until the computer is turned off"

(Girouard; col. 6, lines 3-5). Since malls typically are open for a predetermined amount of time, and are closed at set times, it is readily apparent that the Girouard's system (including notification means) would continue to function after the mall was closed (in its "off-hours"). One having ordinary skill in the art at the time of the invention would have found it obvious to link Girouard's Mall Promotion Network to a remote installation or terminal outside of the mall (Girouard; col. 5, lines 3-6) for access to customers aside from those hours during which the mall is open, with the motivation of accommodating those customers whose schedules for a given day may conflict with mall opening and closing times. For example, the typical mall closes early on Sundays, and the customer curious of his status in receiving an award, coupon, or prize, for that coming week, may have just arrived at the mall a minute or two just after the mall closed. Thus, the satellite terminal (i.e., similar to the well-known 24-hour ATM concept) would serve to notify the customer of his status off-hours.

(F) As per claim 42, Girouard teaches a plurality of multi-media devices and communications circuits as notification means

(Girouard; col. col. 5, lines 15-50 and figs. 2-5). Girouard teaches that his Mall Promotion Network permits the display of electronic advertisements (Girouard; col. 4, lines 56-57) and further teaches employing laser disk (44) as a means of providing TV quality images and as a means of permitting the use of "rolling video", such as that seen on normal TV (Girouard; col. 5, lines 40-43). Thus, it is readily apparent that the Girouard system display seeks to emulate a television display as much as possible. Bidirectional television is well known in the electronic display art and is not considered to have been invented by Applicant, *per se*.

One having ordinary skill in the art at the time of invention would have found it an obvious modification to substitute one type of electronic display mechanism for another, since the Examiner takes Official Notice of the equivalence of such display devices (e.g., bidirectional television, laser disk, videotape, etc.) for activating or animating elements on a display for viewing by the user, and for their use in the electronic display arts, and the selection of any of these known equivalents to display data stored in a computer system would have been within the level of ordinary skill in the art.

Girouard's teachings with regard to the use of store/customer terminals and notifying customer of frequent shopper status or counts (i.e., points) is as discussed above in the rejections of claims 2-3 and 11, and incorporated herein.

(G) New claim 54 differs from amended claim 1 by reciting "point storing means" at lines 8-9. As per this feature, Girouard clearly teaches a memory (12) wherein data regarding a customer's frequent shopper status is stored upon a match with the customer's entered ID and a shopper ID (Girouard; col. 20, lines 5-9). Further, Girouard teaches an award means that awards prizes to customers "based on a comparison by the control program means of the updates of the frequent shopper field and a schedule stored in the computer means" (emphasis added)(Girouard; col. 24,,lines 30-34).

The remainder of claim 54 is rejected for the same reasons given above and in the prior Office Action, for claim 1.

(H) New claim 55 is similar in scope to originally filed claims 2, and is therefore rejected under the same rationale given for claim 2 in the prior Office Action (paper number 11).

(I) New claims 56-59 differs from amended claims 1, 2, 3, and 11, respectively, in that they omit certain elements. In particular, "means for accumulating points" and "means for notifying each customer" are similar in scope to the "point accumulation means" and "point notification means" of claims 1, 2, 3, and 11. However, new claims 56-59 fail to recite the "point issue means" and "customer identification means" of claims 1, 2, 3, and 11. Although the deletion of the above elements serves to make the present set of claims broader, it has been held that the omission of an element with the subsequent loss of its function is obvious. *In re Porter*, 20 USPQ 298.

As per the recitation of "store terminal" or "customer terminal" in claims 57 & 58, Girouard clearly teaches that his system be located in a mall or other retail area (Girouard; col. 3, line 66) and that customers interact with his system (Girouard; col. 36-55).

As per the recitation of notifying a customer of points prior to a transaction, note the discussion given above in the rejection of claims 2-3 and 11.

Thus, claims 56-59 are rejected under the same rationale held for claims 1-3 and 11, both as given above and in the prior

Office Action.

(J) New claims 60-63 are merely the method "steps" counterparts to the apparatus "means-plus-function" elements of claims 56-59, and are therefore also rejected under the same rationale.

4. Claims 43-44 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girouard et al. (4,982,346) as applied to claims 1 and 41 above, and further in view of Vela et al. (4,882,724).

(A) As per claims 43-44 and 64, Girouard teaches a plurality of multi-media devices and communications circuits as notification means (Girouard; col. col. 5, lines 15-50 and figs. 2-5). Girouard further teaches notifying customer of frequent shopper status or counts (i.e., points), as discussed above in the rejections of claims 2-3 and 11, and incorporated herein.

Girouard is deficient in that he fails to disclose communications means installed in a cart or a videocart such that the customer is notified of point information and specific commodity point information sent to a specific area. However,

this feature is well known in the art, as evidenced by Vela.

Vela teaches a communication system wherein a relay unit (i.e., reads on "communication means") is mounted and transported about the marketing area on a cart used by a consumer (Vela; col. 2, lines 19-24). The relay units provide visually displayable messages and video transmissions (i.e., reads on "videocart"), as controlled by a computer system (Vela; col. 2, lines 25-46) and dependent upon pre-determined zones (i.e., reads on "specific areas") in a marketing area dedicated to specific types of electronic displays or visually displayable messages (Vela; col. 3, lines 50-61 and col. 36, line 63 to col. 37, line 29).

One having ordinary skill in the art at the time of the invention would have found it obvious to modify the communication links and display monitors of Girouard's Mall Promotion Network (Girouard; figures 1-5) to include the relay units on carts and videocarts disclosed by Vela and discussed above, with the motivation of providing a system that is easily transportable and accessible by the user at a shopping mall (Vela; col. 2, lines 15-24 and Girouard; abstract and col. 3, line 63 to col. 4, line 2).

Response to Arguments

5. Applicant's arguments filed 8/28/96 have been fully considered but they are not persuasive.

(A) At the paragraph bridging pages 18-19 of the response filed 8/28/96, Applicant argues that the structure of the present invention is patentable distinct from that of Girouard in that the present invention requires a new timing notification process which gives a timing trigger for notifying customers of point information prior to their transactions, different from changing or updating point values during usual notification.

In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., "a new timing notification process which gives a timing trigger for notifying customers of point information prior to their transactions, different from changing or updating point values during usual notification") are not recited in the rejected claim(s). Therefore, it is irrelevant whether the reference includes those features or not.

Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, it appears Applicant misinterprets the principle that claims are interpreted in the light of the specification. Although this element (i.e.,"a new timing notification process which gives a timing trigger for notifying customers of point information prior to their transactions, different from changing or updating point values during usual notification") may be found as an example or embodiment in the specification, it was not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require such a limitation. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Further, Applicant does not point to any specific portion of the specification for support of the disputed feature.

In response to the recitation of notifying customers of issued points prior, not subsequent, to carrying out their transactions, the Examiner respectfully submits that this feature is obvious in light of that knowledge generally available to one having ordinary skill in the art of electronic advertising and

promotionals, as discussed in detail in the rejections of claims 2-3 and 11 above in section (3)-(B) of the present Office Action and in the rejection of claim 1 in the previous Office Action (paper number 11; section (5)-(A), pages 5-6).

Furthermore, the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

(B) At page 19 of the response filed 8/28/96, Applicant argues that, in contrast to the Girouard apparatus, the present invention does not require the use of a bar code reader.

In response, the Examiner respectfully submits that the claim language used by Applicant does not require the applied references be exclusively limited to those elements recited within the claims. Insofar as Applicant uses the word "comprising" at the end of the preambles of each independent claim, the Examiner understands this language as meaning "having at least". As such, it is irrelevant whether the applied

reference contains elements in addition to or beyond those claimed by Applicant, and not required by Applicant. If Applicant desires to claim an invention that is exclusively limited to those elements specifically recited in the claims, the Examiner suggests that Applicant use the term "consisting of" rather than "comprising".

(C) The remaining arguments presented by Applicant at pages 19-20 of the response filed 8/28/96 merely rehash the issues discussed above, and are therefore considered moot for the reasons set forth in the preceding responses (A)-(B) as well as those reasons given in rejections of the pending claims in sections 3-(A) through 3-(J) and 4-(A) of the present Office Action.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied patents teaches various systems and methods for awarding credit points/values or cumulative discount certificates to shoppers (5,117,355; WO 92/14213; and WO-94/09454);

bidirectional television systems (4,361,903 & 4,972,504), and videocart systems (5,250,789; 5,264,822; and 5,295,064). The cited but not applied prior art also includes an article on the Vision Value concept of using smart cards in offering promotional discounts and bonus points to the shopper.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action (i.e., the rejection under 35 U.S.C. § 112, second paragraph). Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory

period for response expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Thomas, whose telephone number is (703) 305-9588. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiners' supervisor, Gail Hayes, can be reached at (703) 305-9711. The fax phone number for this Group is (703) 305-9731.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

J. T.

Joseph Thomas
November 22, 1996

ROBERT A. WEINHARDT
PRIMARY EXAMINER
GROUP 2400